Patents and Intellectual Property
Overview of IP: The USPTO in 2014

- 8,611 Patent Examiners
- 618,330 Patent Applications Filed
- 329,613 Patents Issued
- 429 Trademark Examining Attorneys
- 336,275 Trademark Applications
- 206,555 Certificates of Registration

USPTO Headquarters in Alexandria, VA

3/10/2016
# Overview of Intellectual Property

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<th>What is protected</th>
<th>Utility Patent</th>
<th>Design Patent</th>
<th>Trade Secrets</th>
<th>Copyrights</th>
<th>Trademarks</th>
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</thead>
<tbody>
<tr>
<td>Inventions – Process, machine, manufacture, or composition of matter</td>
<td>Ornamental characteristics embodied in, or applied to, an article of manufacture</td>
<td>Business-related information (formulas, techniques, information)</td>
<td>Art, in an all-encompassing sense</td>
<td>Marks that indicates the source or origin of goods or services</td>
<td></td>
</tr>
<tr>
<td>Requirements</td>
<td>Utility, novelty, and nonobviousness</td>
<td>Novelty and nonobviousness</td>
<td>Commercial value, generally not known, and reasonable efforts of secrecy</td>
<td>Original, authorship, and fixation in a tangible medium</td>
<td>Use in commerce and either distinctiveness or secondary meaning</td>
</tr>
<tr>
<td>Protects Against...</td>
<td>Making, selling, offering for sale, and importing</td>
<td>Making, selling, offering for sale, and importing</td>
<td>Stealing</td>
<td>Copies, performances, displays, and derivative works</td>
<td>Use of a mark that causes the likelihood of confusion</td>
</tr>
<tr>
<td>Endures until...</td>
<td>20 years from filing date</td>
<td>15 years from issuance</td>
<td>Publicly disclosed</td>
<td>The life of the author + 70 years</td>
<td>Abandoned</td>
</tr>
<tr>
<td>Rights of Independent Third Party Creators</td>
<td>None</td>
<td>None</td>
<td>Full</td>
<td>Full</td>
<td>None</td>
</tr>
</tbody>
</table>

3/10/2016
Overview of IP: The Mobile Phone

Trademarks:
• Made by “Apple” (logo)
• Product “iPhone”
• Software “iOS”, “Safari”

Patents:
• Semiconductor circuits
• Touch Screen
• Battery/Power Control
• Antenna
• Speaker
• Device Housing

Trade secrets:
• ???

Copyrights:
• Software code
• Instruction manual
• Ringtone
• ...

Designs (some of them patented):
• Form of overall phone
• Placement of button & speaker
• Color pattern of trim
• Surface finish
Overview of IP: Trademarks

Common Law
- protection derived from use (™)

State Registration
- registered with one or more U.S. states

Federal Registration
- registered in the U.S. Patent and Trademark Office

Protects against confusion as to the source of goods or services, not from competition that does not confuse customers
Overview of IP: Registered Trademarks

- Right to enforce nationally and bring legal action in federal courts
- Use of federal Trademark registration symbol ®
- Right to record mark with Customs
- Serve as basis for foreign filing
- Publication in U.S. Trademark database
Overview of IP: Copyright

– Protects “original works of authorship” including literary, dramatic, musical, artistic and certain other intellectual works fixed in a tangible medium

– Library of Congress administers registration; USPTO advises the Executive branch on intellectual property issues including copyright

– © symbol represents an identification of the owner, not an indication that the copyright has been registered
Overview of IP: Copyright

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Overview of IP: Source of Authority

Patents and Copyrights

- “The Congress shall have the power... To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries” (U.S. Const., Art. I, Sec. 8, emphasis added)
- First patent statute and first copyright statute enacted in 1790 during the first Congress

- Trademarks
- “The Congress shall have the power... To regulate commerce with foreign nations, and among the several states”
- First federal statutes were enacted in 1870 and 1881
Overview of IP: Trade Secrets

- Any information that derives economic value from not being generally known or ascertainable
- Can be formulas, patterns, compilations, programs, devices, methods, techniques or processes
- Protection stems from common law dating to the 1800’s
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- In 2014 Congress considered, but did not pass, federal versions of the UTSA
Overview of IP: Why Trade Secret?

Trade Secret Basics:

- Protects *commercially valuable proprietary information*, e.g., formulas or business information that gives a *competitive advantage*
  - Customer lists
  - Product formulations
  - Search algorithms
- Trade Secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality

Common Ways to Lose a Trade Secret:

- Failure to take adequate steps to prevent disclosure
- Owner or owner-authorized disclosure
- Reverse engineering
- Independent development
Overview of IP: Patents

- Right to **exclude others** from making, using, selling, offering for sale or importing the claimed invention
- Right conditional on inventor applying for, and USPTO issuing, a patent
- Strict time limits to apply for a patent
- Limited term
- Territorial: protection only in territory that granted patent; **NO world-wide patent**
Overview of IP: Patents

- Protect inventions
- Publish so that others can understand advances in technology
- Promote commercialization and application of inventions
- Incentivize investment in future inventions

Protect inventions

Publish so that others can understand advances in technology

Promote commercialization and application of inventions

Incentivize investment in future inventions
Overview of IP: Patents Quid Pro Quo

Time-Limited Monopoly

Discloses Invention
Overview of IP: Why Get a Patent?

- A patent can be
  - Used to gain entry to a market
  - Used to exclude others from a market
  - Used as a marketing tool to promote unique aspects of a product
  - Sold or licensed, like other property
What information should a patent application claim?

Patent Scope

Too Specific

Invention

Too General

Too General

Not patentable

Not valuable
Examination: Role of Patent Examiner

• Issue Valid Patents
  – Make appropriate objections
  – Make only reasonable rejections
  – Help applicant identify allowable subject matter

• Act as an advocate for the Public
  – Ensure development of clear and complete file record
  – Patent prosecution before Office should not be adversarial, instead it should be cooperative investigation between Examiner and Applicant, which ensures Applicant receives a patent only for that which they are entitled to in accordance with Patent laws
Examination: What May an Examiner Do?

- Advise on advantages of, and appropriate classification fields for, pre-examination search
- Advise on advantages of securing services of a competent patent attorney or agent
- Advise on Office fees and Office procedures in general
- Assist public in conducting a search, short of rendering patentability advice or opinion as to whether an application should be filed
What is patentable?

NEW, USEFUL, NONOBSVIOUS, ENABLED & CLEARLY DESCRIBED
How to Read a Patent: Cover Page

Scope of protection is not defined by the title or the picture on the front!
The USPTO is moving to harmonize with the European Patent Office on a classification scheme. G10D is Stringed Instruments.
Do I really need a patent?
- Myths -

• “If I just publish, I will prevent anyone from getting a patent on my invention”
  – What if already patented?
  – No Patent Claim = No Protection
  – Can’t exclude others from market
  – You may be excluded from using

• “I’m not going to get a patent, because other countries will steal my invention”
  – How will you keep it secret?
Provisional Patent Applications

- A low-cost way to establish an early effective filing date (priority date) in non-provisional patent application with fewer formalities

- 12 month window to file corresponding utility patent application in order to benefit from the priority date of the provisional application
  - Caution – earliest effective filing date for any new matter filed in utility application is the filing date of the non-provisional application

- Provisional application is abandoned automatically at 12 months and is not examined

- Patent term measured from filing date of subsequent non-provisional application
## Basic Fees

**Provisional Application Filing Fee:** $260/$130/$65

### Utility
- **Basic filing fee**
  - $280/$140/$70
- **Search Fee**
  - $600/$300/$150
- **Examination fee**
  - $720/$360/$180
- **Issue**
  - $960/$480/$240

### Design
- **Basic filing fee**
  - $180/$90/$45
- **Search fee**
  - $120/$60/$30
- **Examination**
  - $460/$230/$115
- **Issue**
  - $560/$280/$140
Patent Infringement in the U.S.

Occurs when –

Without authorization of patent owner:

— Making or using the invention
— Offer to sell or sells within the U.S.
— Import the invention into the U.S.
— Actively induce infringement by another
Enforcement Considerations

- Burden is on the Patent Owner
- Enforceability of patents
  - Effectiveness of enforcement laws and procedures in the country/region of interest
    - Some countries allow recordation of patent with customs
- Competitor products should be monitored
  - In stores
  - At trade shows
- Licensing may be beneficial
  - Limit as to time, geographical area, or field of use
Resources

• Comprehensive Information and Training Material for First Inventor to File: http://www.uspto.gov/aia_implementation/patents.jsp#heading-10
• Inventor Resources: http://www.uspto.gov/inventors/index.jsp

Other Resources:
• Education for the Public (including IP Awareness Assessment Tool)
• Pro Bono
• Law School Clinical Program
• Pro Se Assistance
• Satellite Offices
• Scam Prevention
Education for the Public

- Web-based resources
  - Videos
  - Tutorials
  - webinars
- Conferences and seminars
- Smithsonian collaboration
- IP Awareness Assessment Tool
  
Micro-entity

• SMALL ENTITY REQUIREMENT –
• APPLICATION FILING LIMIT – no more than four previously filed applications
• GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS – equal to three times the median household income for the preceding calendar year ($155,817 for 2013)
• GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST"
Satellite Offices

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  - Invention Promoters

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